

REMARKS

Upon entry of the present amendment, claims 1-5, 7-14, and 18-19 will be pending in the application. Claims 6 and 15-17 have been canceled and claim 19 has been added.

Claims 1-5, 7-14, and 18 been amended, in accordance with the requirements of U.S. patent practice, in order to more specifically claim the invention.

Claim 1 has been amended to include the limitation of claim 6, now canceled, that “the weight ratio (A):(B) is chosen so that the PVC plastisol exhibits pseudoplasticity”. Claim 1 has also been amended to include the limitation of “(F) at least one additive, wherein the at least one additive (F) is an organic solvent”. Support is found at least in previously presented claim 6, on p. 10, ll. 11 and 15-16, and in Examples 1-3 (Table 1, p. 15, l. 12).

The term “PVC plastisol” has been replaced by “coating composition” in claims 1-5, 7-14, and 18. Support can be found at least on p. 10, ll. 25-28 and in Examples 1-3 on p. 13, l. 25 to p. 19, l. 37.

Claims 3 and 14 have also been amended to have proper antecedent basis.

Amendments to, cancellation of, and additions to, the claims, as set forth above, are made in order to streamline prosecution in this case by limiting examination and argument to certain claimed embodiments that presently are considered to be of immediate commercial significance. Amendment or cancellation of the claims is not in any manner intended to, and should not be construed to, waive Applicants' right in the future to seek such unamended or cancelled subject matter, or similar matter (whether in equivalent, broader, or narrower form) in the present application, and any continuation, divisional, continuation-in-part, RCE, or any other application claiming priority to or through the present application, nor in any manner to indicate an intention, expressed or implied, to surrender any equivalent to the claims as pending after such amendments or cancellations.

Reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

1. **Rejection of claims 15-17 under 35 U.S.C. 101 as being directed to non-statutory subject matter.**

Claims 15-17 have been canceled rendering this rejection moot. New claim 19, drawn to a method of producing an effect coating comprising “applying the coating composition of claim 1 onto a metal strip, and thermally curing the coating composition”, has been drafted to replace these claims. Antecedent basis for this claim is found at least on p. 10, l. 25 to p. 12, l. 24.

2. **Rejection of claims 1-14 and 18 under 35 U.S.C. 102(b) as being anticipated by Colyer et al. (U.S. Patent No. 5,223,322), hereafter “Colyer”, or Hensler et al. (U.S. Patent No. 5,695,696), hereafter “Hensler”.**

The PTO contends,

Colyer et al. disclose a composition consisting of dispersion resin, blending resin, plasticizers, stabilizer and platelet pigment in column 7, lines 5-10. Hensler et al. teach compositions with or without blowing agents in column 3, lines 1-25. Phosphorescent pigments are described in column 4, lines 39-47. Applicants' claims are not novel.

(Office Action, p. 2, Section 4)

Applicants appreciate the detailed basis of rejection but must respectfully disagree in regard to the inventions of amended independent claims 1 and 14, and new claim 19.

A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference. *In re Paulsen*, 31 U.S.P.Q.2d 1671 (Fed Cir. 1994). Moreover, there must be no difference between the claimed invention and the disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Res. Found. v. Genentech Inc.*, 18 U.S.P.Q.2d 1001 (Fed. Cir. 1991).

However, Applicants' review of the cited sections of Coyler and Hensler, relative to Applicants' amended independent claim 1, indicates that Coyler and Hensler each fails to satisfy the requirements for anticipation.

For example, Coyler is silent on the particle sizes of the PVC resins disclosed therein.

Hensler discloses a paste grade PVC resin having a particle size of 0.1-2.0 microns (col. 3, ll. 33-35), but is silent on the particle size of the *second* PVC resin, or blending resin, other than to characterize the particle size as "large" (col. 3, ll. 41-51). Therefore Hensler does not disclose one PVC resin having a particle size of 0.04 to 40 μm and a second PVC resin having a particle size of 1 to 400 μm .

Moreover, Coyler and Hensler are silent on the viscosity characteristics of the PVC compositions disclosed therein. Neither reference teaches blending (A) and (B) in a weight ratio such that the PVC plastisol exhibits pseudoplasticity, as required by claim 1. Absent too, from the compositions of Coyler and Hensler, is an organic solvent, also required by claim 1.

Since neither Coyler nor Hensler disclose all of the limitations of claim 1 as herein amended, Applicants respectfully submit that claim 1 is not anticipated by the references. Therefore reconsideration and removal of the anticipation rejection of claim 1, claims 14 and 19, which incorporate all the limitations of claim 1, and claims 2-5, 7-13, and 18, which depend therefrom, is requested.

3. Rejection of claims 1-14 and 18 under 35 U.S.C. 103(a) as being obvious over Coyler et al. (U.S. Patent No. 5,223,322), hereafter "Coyler", Hensler et al. (U.S. Patent No. 5,695,696), hereafter "Hensler" or Marecki (U.S. Patent No. 5,837,347), hereafter "Marecki".

The basis of the rejection is understood to be as follows:

Marecki displays a plastisol made from dispersion resin and extender resin in column 5, lines 20-30, effect pigments in column 11, lines 20-39

and pigments in the plastisol layer in claims 17 and 18. The other references have been described already. It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to select applicants' ingredients from a list of equivalents.

(Office Action of 2/17/09, p. 3, Section 8)

Applicants appreciate the detailed basis of the rejection but must respectfully disagree in regards to the inventions of amended independent claims 1 and 14, and new claim 19.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.

Establishing a *prima facie* case of obviousness requires that all limitations of the claim be taught or suggested by the prior art. See, e.g., *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003); *In re Royka*, 490 F.2nd 981, 985 (C.C.P.A. 1974). This standard has not been met with the instant rejection. The three references, alone or in combination, fail to teach or suggest all the claim limitations. Coyler, Hensler, and Marecki are all silent on the viscosity characteristics of the PVC compositions disclosed therein. None of the references teaches blending PVC resins (A) and (B) in a weight ratio such that the PVC plastisol exhibits pseudoplasticity, as required by claim 1. Absent too, from the compositions of Coyler, Hensler, and Marecki is an organic solvent, also required by claim 1.

The Supreme Court has stated that “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does”. *KSR Int’l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). And the Court expressly encouraged the use of common sense in such analysis. *Id.* No motivation to combine the teachings of Coyler, Hensler, and

Marecki has been provided. These references teach completely different applications for PVC plastisols, and none of the references teach a PVC plastisol composition suitable as a coil coating composition.

Coyler is directed toward decorative surface coverings, primarily floor coverings (col. 1, ll. 31-34). Example 1 is a flooring structure containing a rotogravure image (col. 6, l. 49 to col. 7, l. 54). Hensler is directed toward floor mats with phosphorescent borders (Abstract). Marecki is directed toward retroreflective transfer sheets and appliqués designed for application to articles of clothing (Abstract, col. 13, ll. 31-36). The skilled person in the art at the time the invention was made would not look to these references with the disparate articles taught therein for guidance on making a coating composition.

Taken as a whole, it is respectfully submitted that the cited combination of references fails to provide the requisite motivation for a *prima facie* case of obviousness. Reconsideration and removal of the obviousness rejections of claim 1, claims 14 and 19, which incorporate all the limitations of claim 1, and claims 2-5, 7-13, and 18, which depend therefrom, is requested in view of the foregoing amendments and remarks.

CONCLUSION

Applicants respectfully submit that the Application and pending claims are patentable in view of the foregoing remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

/MaryEGolota/
Mary E. Golota
Registration No. 36,814
Cantor Colburn LLP
(248) 524-2300

Friday, August 14, 2009
CORRESPONDENCE ADDRESS ONLY

BASF CORPORATION
1609 Biddle Avenue
Wyandotte, MI 48192
Customer No. 77224

MEG/DJJ